



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,807	11/24/2003	Michael Lee Millard	13DV-14030 (07783-0110)	5428
31450 7590 04/26/2007 MCNEES WALLACE & NURICK LLC 100 PINE STREET P.O. BOX 1166 HARRISBURG, PA 17108-1166			EXAMINER MOORE, MARGARET G	
			ART UNIT	PAPER NUMBER
			1712	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/720,807

Applicant(s)

MILLARD ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4 to 10, 20 to 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 to 10, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Art Unit: 1712

1. The rejection over Stowell et al. has been overcome for reasons of record. Most importantly, patentees fail to teach or adequately suggest the particle size range as claimed in addition of a plasticizer in an amount as claimed.

In addition, the Examiner has withdrawn the rejection under 35 USC 112. This is not based upon applicants' remarks but upon reconsideration of the teachings in Ruud et al. and the closeness thereof to the instant claims. Previously the Examiner had believed that the teachings in Ruud et al. and the instant claims were close enough to one another to raise the question of what exactly is embraced by "about". She could not determine if the term "about" in the claims gave them such breadth that the teachings of Ruud et al. could anticipate and/or render obvious the claims. However the Examiner has reviewed the teachings in Ruud et al. and finds them to be too general and too confusing for her to determine the actual wt% of each component in the compositions thereof. From the examples in which one can determine the wt% of each component, they are certainly not close enough for the skilled artisan to consider them as possibly teaching and/or rendered obvious the claims. The rejection under 35 USC 112 was based upon the position of close prior art but the Examiner no longer considers the teachings in Ruud et al. to be close prior art.

2. In the previous office action, the Examiner did not include claim 3 in the rejection over MacDougald et al. This occurred because, at the time, the Examiner did not have an adequate knowledge of the "mesh" particle size determination. Upon reconsideration the Examiner has determined that claim 3 *should* have been included in the rejection over MacDougald et al. As such claim 1, which now includes the limitation of previous claim 3, is subjected to a rejection over MacDougald et al. (see below) and this action cannot be made final.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 1 is objected to because of the following informalities: The word "form" in "range in size form about" should be "from". Appropriate correction is required.

5. Claims 1, 2, 4 to 10, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougald et al.

The teachings of MacDougald et al. were detailed in the previous office action; as such this will not be repeated. In an effort to distinguish the claims from the prior art applicants have inserted the requirement that the ceramic particles range in size from about -20 mesh to about +50 mesh. See page 11, the first full paragraph, of applicants' response. Attached to this office action is a sheet explaining particle size by mesh designation. If a "-" is before a sieve mesh, this indicates that the particles, typically 90% or more, will pass *through* the sieve (i.e. the particles will be smaller than the sieve size). In the instant claims the lower limit of -20 means that at least 90% of the particles will have a particle size *smaller* than 841 microns. As applicants admit, MacDougald et al. teach a particle size range of from .1 to about 50 microns. This falls well within the claimed range, which includes particle sizes less than 841 microns. As such, this limitation fails to overcome the rejection over MacDougald et al.

Applicants also argue that MacDougald does not teach or suggest forming a pliable composition that conforms to and substantially fills a void between the radius region and the skin member of a ceramic composite stiffener. Applicants are reminded, though, that the claim is drawn to a composition *capable* of being rolled into a cylinder which conforms to and substantially fills a void between the radius region and the skin member of a ceramic composite stiffener. The Examiner noted in the previous office action that the composition in MacDougald et al. is putty like and pliable. It is reasonable for the skilled artisan to conclude that the composition therein is "capable" of being rolled into a cylinder as claimed. This language is, in fact, a future intended use of the composition. Applicants need not teach the same future intended use of a composition for the composition to be rendered obvious. A prima facie case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention. In re Dillon 16 USPQ2d 1897 (CAFC, en

Art Unit: 1712

banc, 1990), which overrules *In re Dillon* 13 USPQ 2d 1337 and *In re Wright* 6 USPQ 2d 1959.

Though not specifically argued by applicants, the Examiner notes that the breadth of the term "plasticizer" is such that the dispersing agent in MacDougald et al. meets this requirement. The definition of plasticizer supplied by applicants indicates that it will facilitate processing and increase flexibility and toughness. In MacDougald et al., the dispersing agent improves flow, thus facilitating processing. It also aids in improving mechanical properties (column 7, lines 15 to 18, lines 45 to 47).

The Examiner is supplying a different definition of plasticizer as being drawn to a substance that makes the material softer and more flexible. A composition that improves the flow corresponds to making the material softer and more flexible.

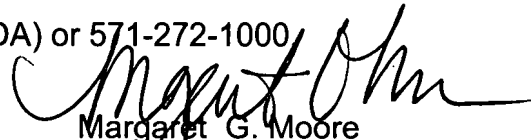
6. Claim 22 is objected to as being based on a rejected base claim but not taught or suggested by the prior art.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
3/7/07